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PATRICIA A. RUBIO

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Signature of Patricia A. Rubio

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07278

PATENT TRADEMARK OFFICE

Docket No.: 2875/1G342US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Samuel Sergio TENENBAUM

Serial No: 09/922,232

Confirmation No. 7566

Filed: August 3, 2001

For: COMPUTERIZED ADVERTISING METHOD AND SYSTEM

REQUEST FOR RECONSIDERATION OF PETITION TO MAKE SPECIAL

Commissioner of Patents and Trademarks  
Washington DC 20231

Sir:

It is respectfully requested that the undated decision on Petition to  
Make Special in the above-identified patent application (Paper No. 6) be reconsid-  
ered in view of the comments which follow.

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One basis on which the petition was found to be deficient is that "it has not been expressly stated that a rigid comparison has been made between the infringing device, product or method with the claims of the application."

In response, the undersigned states that: on November 7, 2001, he found advertising material on Yahoo.com and made a rigid comparison between that material and the claims of the present patent application. The undersigned concluded that at least one of the claims was unquestionably infringed.

The undersigned also wishes to state for the record that the parent of the present patent application is international application No. PCT/US00/30987. As stated in the initial petition, this application was subjected to preliminary examination by IPEA/US. This examination was based upon a careful and thorough search by a U.S. examiner, which was the subject of an international search report issued in the previously identified international application. In accordance with the usual procedure of IPEA/US, the IPER was based upon this search report. The copy of the IPER submitted with the original petition indicates that the present application meets all standards of allowability including novelty, and inventive step, and industrial applicability.

On July 19, 2002, the undersigned filed an information disclosure statement in this application which included a copy of the international search and all of the references cited in the international search report. A copy of that infor-

mation disclosure statement, including a copy of each reference cited therein is attached as Exhibit A.

The examiner also indicated that the present application was filed as a continuation of the international application, not under 35 U.S.C. §371. He did not specifically state that this would be a basis for denying a petition to make special, but suggested so.

Such decision would truly be placing form before substance. The present application not only stands in the shoes of the international application, but has satisfied every criterium for the granting of a petition to make special. Such petition is based upon the substantive circumstances surrounding the application and not how it arrived at the national stage.

The fact is that after a recently filed amendment (discussed below) the claims in the present application are identical in scope to the claims of the international application. The substantive examination has been done by a U.S. examiner and all of the claims in the present application were found to satisfy the criteria of PCT Article 33(1)-(4). In other words, there is every reason to advance the examination of this application and the fact that this is a continuation of the international application, rather than the formal national stage version thereof should have no substantive effect.

The undersigned wishes to advise that on July 19, 2002, an amendment was filed in the above-identified patent application which made the scope of

its claims identical to the scope of the claims in the international application. A copy of that amendment is attached as Exhibit B.

As a result of the amendment, the application now contains Claims 1-52 and 58-62. For the examiner's convenience, the undersigned has prepared the attached Table I which shows how the claims in the present application correspond to claims in the international application. In view of the present response, it is believed that the undersigned has firmly established the two grounds originally set forth to make this patent application special and that the petition should therefore be granted. However, it is noted that the original petition inherently included a third ground for making the application special, and it is requested that such ground also be considered.

That third ground is that this patent application also satisfies the requirements of MPEP §70802 VIII. The present application inherently includes claims directed to a single invention, since the examiner in the international application so concluded, and the present application contains only claims that were present in the international application. In addition, an international search report was issued by ISA/US. A copy of that international search report is part of attached Exhibit A and it indicates the field of search as US Class 705, Subclasses 10, 14 and 26. On copy of each cited reference has been submitted (Exhibit A). Also, the search report includes a detailed categorization of each reference, showing those claims to which it is relevant, and this meets the

"detailed discussion" requirement of the MPEP. The preliminary examination report, already submitted, provides a detailed explanation of how the present claims are distinguishable over these references. Thus, the present applicant has also satisfied a third, separate ground for this petition to be granted.

In view of the foregoing, the petitioner has now provided three separate, well supported grounds for granting of the petition to make special, and it respectfully requested that this be done.

Respectfully submitted,

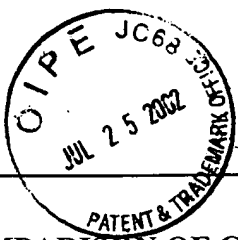
  
Joseph B. Lerch  
Reg. No. 26,936  
Attorney For Applicant(s)

DARBY & DARBY P.C.  
P.O. Box 5257  
New York, NY 10150-5257  
(212) 527-7700

Enclosures:

- IDS filed July 19, 2002
- Amendment filed July 19, 2002
- Table I
- Preexamination Search Report

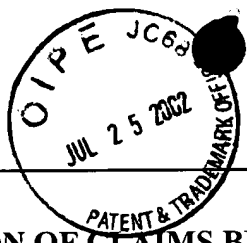
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**TABLE 1**  
**COMPARISON OF CLAIMS BETWEEN THE PRESENT APPLICATION AND**  
**THE INTERNATIONAL APPLICATION**

Claim Number In Present Application	Corresponding Claim In International Application
1	1
2	2
3	3/ 2
4	4/ 3/ 2
5	5/ 4/ 3/ 2
6	6/ 5/ 4/ 3/ 2
7	7/ 6/ 5/ 4/ 3/ 2
8	8/ 7/ 6/ 5/ 4/ 3/ 2
9	9/ 8/ 7/ 6/ 5/ 4/ 3/ 2
10	10/ 9/ 8/ 7/ 6/ 5/ 4/ 3/ 2
11	11/ 10/ 9/ 8/ 7/ 6/ 5/ 4/ 3/ 2
12	12
13	13
14	14/12
15	15/ 14/ 12
16	16/ 15/ 14/ 12
17	17/ 16/ 15/ 14/ 12
18	18/ 17/ 16/ 15/ 14/ 12
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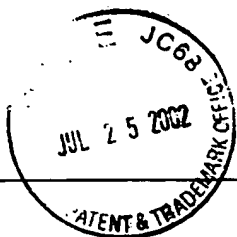
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**TABLE 1**  
**COMPARISON OF CLAIMS BETWEEN THE PRESENT APPLICATION AND**  
**THE INTERNATIONAL APPLICATION**

Claim Number In Present Application	Corresponding Claim In International Application
25	25
26	26/ 25/ 24
27	27/ 26/ 25/ 24
28	28/ 27/ 26/ 25/ 24
29	29/ 28/ 27/ 26/ 25/ 24
30	30/ 29/ 28/ 27/ 26/ 25/ 24
31	31/ 30/ 29/ 28/ 27/ 26/ 25/ 24
32	32/ 31/ 30/ 29/ 28/ 27/ 26/ 25/ 24
33	33
34	3/ 1
35	4/ 1
36	5/ 1
37	6/ 1
38	7/ 6/ 1
39	8/ 7/ 6/ 1
40	9/ 1
41	10/ 9/ 1
42	15/ 12
43	16/ 12
44	17/ 12
45	18/ 12
46	19/ 12
47	20/ 19/ 12
48	26/ 23

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<b>TABLE 1</b> <b>COMPARISON OF CLAIMS BETWEEN THE PRESENT APPLICATION AND</b> <b>THE INTERNATIONAL APPLICATION</b>	
<b>Claim Number In Present Application</b>	<b>Corresponding Claim In International Application</b>
49	27/ 23
50	28/ 23
51	29/ 28/ 23
52	30/ 28/ 23
53	CANCELED
54	CANCELED
55	CANCELED
56	CANCELED
57	CANCELED
58	4/ 3/ 1
59	5/ 3/ 1
60	8/ 6/ 1
61	9/ 8/ 6/ 1
62	10/ 9/ 8/ 6/ 1

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